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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/719,903	12/20/2000	Stefan Etzold	ETZOLD ET AL	7099

7590

01/02/2003

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EXAMINER

SALVATORE, LYNDIA

ART UNIT

PAPER NUMBER

1771

DATE MAILED: 01/02/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/719,903

Applicant(s)

ETZOLD ET AL.

Examiner

Lynda M Salvatore

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-- The MAILING DATE of this communication appears on the cover sheet with the corresponding address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 September 2002.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6,8,9,11-17 and 19-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6,8,9,11-17 and 19-24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 20 December 2002 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. 09/719,903.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s) _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

Response to Amendment

1. Applicant's amendment, Paper No. 8 was entered only in part. Applicant's amendments to claims 1-6, 8,9, and 11-17 have been entered as requested and claims 7,10, and 18 have been canceled. The amendments to the Specification were not entered as requested for not complying with 37 CFR 1.121. Specifically, it is now improper to replace single pages in the Specification. It is suggested that the Applicant submit a substitute Specification having consecutively numbered pages (i.e., whole numbers, not 1a, 1b, etc.).

2. Applicant's amendments are sufficient to withdraw the prior art rejections of claims 1-24 as set forth in the last Office Action. Specifically, the prior art of record now fails to teach the claimed invention set forth in newly amended claims 1-6,8,9, and 11-17.

Claim Objections

3. Claims 1,5,6, and 9 are objected to because of the following informalities:

4. Claim 1 contains multiple "whereby" phrases. It has been held that the functional "whereby" statement does not define any structure and accordingly cannot serve to distinguish. *In re Mason*, 114 USPQ 127, 44 CCPA 937 (1957). Appropriate correction is required.

5. Claims 5 and 6 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. With regard to claim 5, the recitation of feeding the fibrous web to the bonding unit after the hole structures are created does not further limit claim 1

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and the phrase "wherein the fourth step directly follows the third step" is also not further limiting with respect to claim 1.

6. Claim 9 is objected to for using the same reference number (34) to represent the pressure source and the vacuum source in claim 8.

Drawings

7. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because reference character "34" has been used to designate both the pressure source and vacuum source. A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 112

8. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

9. Claims 1-6, 12, and 17 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. Claims 8, 9, 11, 13-16, and 19-24 are further rejected for their dependency on claim 1.

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10. Claim 1 is indefinite because of the phrasing of the sequence of events in steps 2 and 3. Specifically, step 2 is interpreted as the transport step and step 3 as the hole creating step. As such, it is confusing to recite the elements of the hole-structure-creating-unit in step 2 when the holes are not created until step 3. In this way, step 3 appears redundant. The Examiner suggests

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moving the description of the hole-structure-creating unit down to step 3 to clarify the method steps.

11. Claim 2 is indefinite because it is unclear to the Examiner if the fibrous web is “stiffened” by another means in addition to the thermobonding, which inherently occurs as a result of calendaring.

12. A broad range or limitation together with a narrow range or limitation that falls within the broad range or limitation (in the same claim) is considered indefinite, since the resulting claim does not clearly set forth the metes and bounds of the patent protection desired. Note the explanation given by the Board of Patent Appeals and Interferences in *Ex parte Wu*, 10 USPQ2d 2031, 2033 (Bd. Pat. App. & Inter. 1989), as to where broad language is followed by “such as” and then narrow language. The Board stated that this can render a claim indefinite by raising a question or doubt as to whether the feature introduced by such language is (a) merely exemplary of the remainder of the claim, and therefore not required, or (b) a required feature of the claims. Note also, for example, the decisions of *Ex parte Steigewald*, 131 USPQ 74 (Bd. App. 1961); *Ex parte Hall*, 83 USPQ 38 (Bd. App. 1948); and *Ex parte Hasche*, 86 USPQ 481 (Bd. App. 1949). In the present instance, claim 3 recites the broad recitation .1-75%, and the claim also recites “especially” 50%, which is the narrower statement of the range/limitation.

13. Claim 4 is indefinite because it is unclear to the Examiner what the Applicant means by “hole structures *are fixed* before feeding the fibrous web”. Is the Applicant subjecting the fibrous web to calendaring before the calendaring in step 4? In other words, as recited it appears that there is another intermediate calendaring/bonding step before the final bonding in step 4.

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14. Claim 12 recites the limitation “first element” in line 1. There is insufficient antecedent basis for this limitation in the claim. In addition reference number (22) is used to represent the “first element” in claim 12 and “the roller” in claims 1 and 11.

15. Claim 17 recites the limitation “second element” in line 2. There is insufficient antecedent basis for this limitation in the claim. In addition reference number (26) is used to represent the “second element” in claim 17 and “the roller” in claim 1.

Claim Rejections - 35 USC § 102/103

16. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

17. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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18. Claims 19-24 are rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Srinivasan et al., US 5,830,555.

The patent issued to Srinivasan et al., is directed to an apertured non-woven fabric comprising one or two outer webs and a film layer sandwiched between (Abstract). A calendar roll simultaneously generates apertures to the passing non-woven web as well as providing heat and pressure to bond the layers together. (Abstract and Figure 2). Srinivasan et al. discloses that the typical aperture area of a non-woven web is 1-50%, however it may be tailored as needed to any shape, size, open area percentage by modifying the calendar roll, bond pattern or process (Column 8, lines 7-14 and Table 5). Figures 9-12 illustrate samples of apertured non-woven fabrics having circular, oval, or diamond shapes. The aperture size and width disclosed by Srinivasan et al. vary from .5-2.5 mm and .25-1.0 mm respectively.

With respect to claims 19-24, it is the Examiner's position that the apertured non-woven fabric of Srinivasan et al., is identical to or only slightly different than the claimed fleece prepared by the method of the Applicant, since both articles are apertured non-woven fabrics made from fibrous webs having another layer attached thereto. Moreover, the percentage of bonding surface, aperture size, and aperture shape of Srinivasan et al., is consistent with the Applicant's claimed fleece. Even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or an obvious variant from a product of the prior art, the claim is unpatentable even though the prior art product was made by a different process. *In re Thorpe*, 227 USPQ 964,966 (Fed. Cir. 1985). The burden has been shifted to the Applicant show

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unobvious differences between the claimed product and the prior art product. *In re Marosi*, 218 USPQ 289,292 (Fed. Cir. 1983). In the instant case, the Srinivasan et al., reference either anticipates or strongly suggests the claimed subject matter. It is noted that if the Applicant intends to rely on examples in the Specification or in a submitted Declaration to show non-obviousness, the Applicant should clearly state how the examples of the present invention are commensurate in scope with the claims and how the comparative examples are commensurate in scope with the Srinivasan et al., reference.

Conclusion

19. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lynda M Salvatore whose telephone number is 703-305-4070. The examiner can normally be reached on M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris can be reached on 703-308-2414. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

ls
December 27, 2002



CHERYL A. JUSKA
PRIMARY EXAMINER